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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,204	07/10/2003	Shunpei Yamazaki	740756-2630	9770
22204	7590	09/21/2005	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			TRAN, TAN N	
			ART UNIT	PAPER NUMBER
			2826	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/616,204

Applicant(s)

YAMAZAKI ET AL.

Examiner

Tan N. Tran

Art Unit

2826

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-18.
Claim(s) withdrawn from consideration: 19-33.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


Minhloan Tran
Primary Examiner
Art Unit 2826

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments filed 09/06/05 have been fully considered but they are not persuasive.

It is argued, at page 2 of the remarks, that "the restriction requirement as being outside the boundaries established in MPEP 806.04(e) and 806.04(f). First, the restriction requirement appears to be based solely on a finding that the different inventions are patentably distinct, without any evaluation whatsoever made with respect to whether or not the inventions are 'specifically different embodiments' as required in MPEP 806.04(f)"; "the outstanding restriction requirement fails to provide any basis for finding that the restricted claims are mutually exclusive as required by MPEP 806.04(f). Indeed, merely finding that claims are patentably distinct does not provide a basis for requiring an election of inventions, since if that were the case every dependent claim ever submitted in an application would not properly be the subject of Restriction Requirement, which of course is not the case" and "certainly claims 19-33 are not properly established as being directed to different mutually exclusive inventions, and at the very least it is respectfully submitted that these claims should be examined in the present". These are not found persuasive because applicant submitted specifically different embodiments such as "Embodiment Mode 1", "Embodiment Mode 2", "Embodiment 1", "Embodiment 2", etc... as recited on pages 9,13,17,23 respectively of applicant's specification. Moreover, applicant did not submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence of admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. Moreover, it clearly shows that the search is not coextensive as evidenced by the different fields of search as cited in the previous restriction requirement. Thus, it is clear that the examination of all of the disclosed species would be an undue burden. Therefore the election requirement is made final as recited in previous office action.

It is argued, at page 3 of the remark, that "without motivation or suggestion to combine the LCD device of Hinata and multicolor luminescent device of Eida". However, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.d. 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.d. 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the applicant made the erroneous assumption that the motivation to combine must be expressly stated in the art of record. From MPEP § 2144:

"The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In *re Fine*, 837 F.d. 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In *re Jones*, 958 F.d. 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Eli Lilly & Co.*, 902 F.d. 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.d. 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) (examiner must present convincing line of reasoning supporting rejection); and *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning)." [Emphasis added].

In the present case, the examiner has presented a line of reasoning supporting his motive to combine which was expressly stated in the rejection in the last office action and is expressly stated in the rejection below. The applicant cannot rebut the examiner's arguments simply by making the inaccurate statement that the examiner has provided no line of reasoning for the applicant to rebut.